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09/492,009	01/27/2000	Hidehiro Ishii	P7156-9069	9342

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EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/492,009	Applicant(s) ISHII ET AL.	
	Examiner HUY T. NGUYEN	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11, 12, 14, 15, 17, 18, 20, 21, 23, 24 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 12, 14, 15, 17, 18, 20, 21, 23, 24 and 26-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9,11-12,14-15,17-182-2123-24 and 26-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not describe the recitation "wherein, when one of the first identifying information and the second identifying information is changed, the other of the first identifying information and the second identifying information changes relative to and in response to the change in the one of the first identifying information and the second identifying information." The specification does not describe that information on the medium can change by themselves. The specification teaches that the change of the information on the medium is performed by means or circuits of an apparatus; not by the information.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9,11,1012,14,21,23,24 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9-12 direct to stored information on medium. The information does not provide functional inter-relationship between the information and the medium to control accessing the information from the medium or impart to any software and hardware structural components to provide certain function that is processed by a computer, the stored information do not make themselves statutory. See MPEP 2100. Further it is noted that the information recited in the body of the claims are mere descriptive non-functional information since the information do not provide any function by themselves and /or interact to any means or circuit in the body of the claims to provide the certain functions to control the apparatus or access other information .

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 9,11-12,14-15,17-18,20-21,23-24 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al (6,577,811) in view of Takahashi et al (5,966,495).

Regarding claim 9, 12, 15, 18, 21 and 24, Kikuchi discloses a recording system (Figs. 2, 63) for recording data on a recording medium(10X) comprising (Figs. 8,9, 19 and 23) : a record information area having record information (Fig. 9), a first identifying information area having first identifying information (Fig. 23) , and a second identifying information area having second identifying information (Fig. 8 and 19) on the recording medium, wherein the record information includes 1) a plurality of first recording units, 2) one or more second recording units (cells) each of which contains one or more the first recording units and 3) one or more third units (video file, video title or program) (Fig. 9) each of which consists of one or more the first recording units, wherein the first identifying information corresponds to each of the one or more second recording units and prevents erasing or editing of a corresponding second recording unit (Fig. 23 column 22 ,line 65 to column 23, line 5) , wherein the second identifying information corresponds to each of the third or more units and prevents erasing or editing of a

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corresponding the third data unit (Figs. 3, 8 and 19, column 14, lines 10-18, column 21, lines 55 -62).

Kikuchi does not clearly specify that the first identification indicating that the unit is logically erased state as being recited in claims 1,12,15,18,21 and 24. Takahashi teaches a recording apparatus having means for providing identification information to indicate that a unit of video information is logically erased state (column 3, lines 50-60). It would have been obvious to one of ordinary skill in the art to modify Kikuchi by using the teaching of Takahashi for and providing generating identification information indicating that the first unit is logically erased state therefore preventing erroneously erasing recording information .

Further Kikuchi as combined with Takahashi teaches that when a change of the first identifying information or second identifying information in response to the change of the first identifying information and second identifying information since Kikuchi teaches the first identifying information and second identifying information corresponds to each other (See Kikuchi Figs. 17, 21 and 54-56, column 67, lines 5-10).

Regarding claim 11, 14,17,20,23 and 26 , Kikuchi further teaches the second identifying information indicates whether a corresponding logical unit is to be protected (Figs. 8 and 19, column 14, lines 10-18, column 21, lines 55 -62) .

Regarding claim 27, Kikuchi discloses a recording system (Fig. 26, column 27, line 65 to column 28, line 10, column 29) for recording data on a recording medium(10X) comprising :

means (32,56) for recoding information on a record information area (Fig. 9), wherein the record information includes 1) a plurality of first recording units, 2) one or more second recording units (cells) each of which contains one or more the first recording units and 3) one or more third units which consists of one or more the first recording units (video file or video title) (Figs. 3, 9 column 11, lines 25-68);

means (32,30) for recording first identifying information on the (Fig. 23, the first identifying information being related to each of the first recording units and including a first data protect flag that prevent erasing or editing of a corresponding first data unit (Fig. 23 column 22, line 65 to column 23, line 5); and

means (32,30) for recording the second identifying information corresponds to each of the third or more units and including second protect flag prevents erasing or editing (Figs. 8 and 19) of a corresponding the third data unit (column 14, lines 10-18, column 21, lines 55-62).

Kikuchi does not clearly specify that the first identification indicating that the unit is logically erased state Takahashi teaches a recording apparatus having means for providing identification information to indicate that a unit of video information is logically erased state (column 3, lines 50-60). It would have been obvious to one of ordinary skill in the art to modify Kikuchi by using the teaching of Takahashi for providing generating identification information indicating that the first unit is logically erased state therefore enhancing the function of the apparatus of Kikuchi in order to preventing erroneously erasing recording information.

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Regarding claim 28, Kikuchi further teaches the first data protect flag that prevent erasing of a corresponding first data unit (Fig. 23 column 22 ,line 65 to column 23, line 5), and the second protect flag prevents erasing (Figs. 8 and 19) of a corresponding the third data unit (column 14, lines 10-18, column 21, lines 55 -62).

Regarding claim 29, Kikuchi further teaches the first data protect flag that prevent editing of a corresponding first data unit (Fig. 23 column 22 ,line 65 to column 23, line 5), and the second protect flag prevents editing (Figs. 8 and 19) of a corresponding the third data unit (column 14, lines 10-18, column 21, lines 55 -62) since the first flag and second flag prevent the changing of the corresponding first data unit and second data unit .

Regarding claim 30, Kikuchi discloses a recording system (Fig. 26, column 27, line 65 to column 28, line 10, column 29)) for recording data on a recording medium(10X) comprising :

means (32,56) for recoding information on a record information area (Fig. 9), wherein the record information includes 1) one or more first recording units (cells) and on or more second recording units (video object title set or files) (Figs. 3, 9 column 11, lines 25-68);

means (32,30) for recording first identifying information on the recording medium (Fig. 23), the first identifying information being related to each of the first data units an including a first data protect flag that prevent erasing or editing of a corresponding first data unit (Fig. 23 column 22 ,line 65 to column 23, line 5); and

means (32,30) for recording second identifying information on the medium, the second identifying information corresponds to each of the second data units and including a second data protect flag that prevents erasing or editing (Figs. 8 and 19) of a corresponding the third data unit (column 14, lines 10-18, column 21, lines 55 -62).

Further for claim 30, Kikuchi teaches that recording of the first data units and second data unit can be set by the user since the user can use a remote control for controlling start and ending recording data on the recording medium.

Kikuchi does not clearly specify that the first identification indicating that the unit is logically erased state. Takahashi teaches an apparatus for providing identification information to indicate that a unit of video information is logically erased state (column 3, lines 50-60). It would have been obvious to one of ordinary skill in the art to modify Kikuchi by using the teaching of Takahashi for and providing generating identification information indicating that the first unit is logically erased state therefore preventing erroneously erased recording information.

Regarding claim 31, Kikuchi further teaches the first data protect flag that prevent erasing of a corresponding first data unit (Fig. 23 column 22, line 65 to column 23, line 5), and the second protect flag prevents erasing (Figs. 8 and 19) of a corresponding the third data unit (column 14, lines 10-18, column 21, lines 55 -62).

Regarding claim 32, Kikuchi further teaches the first data protect flag that prevent editing of a corresponding first data unit (Fig. 23 column 22, line 65 to column 23, line 5), and the second protect flag prevents editing (Figs. 8 and 19) of a corresponding the third data unit (column 14, lines 10-18, column 21, lines 55 -62) since

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the first flag and second flag prevent the changing of the corresponding first data unit and second data unit .

Response to Arguments

7. Applicant's arguments filed 02 February 2007 have been fully considered but they are not persuasive.

Applicants argue that Kikuchi as combined with Takahashi does not teaches "when one of the first identifying information and the second identifying information is changed , the other of the first identifying information and the second identifying information change relative to and in response to the change in the one of the first identifying information and the second identifying information." In response it is noted that Kikuchi as combined with Takahashi teaches that when a change of the first identifying information or second identifying information in response to the change of the first identifying information and second identifying information since Kikuchi teaches the first identifying information and second identifying information corresponds to each other See (See Kikuchi Figs. 17, 21 and 54-56, column 67, lines 5-10).

Applicants agree that there is no motivation to combine Kikuchi with Takahashi since Kikuchi direct to DVD application and Takahashi direct to a DV camera . In response it is noted that applicants argument does not reflect the claims since nowhere claims do they specify the kind of the information on the medium , or the information on the medium direct to only DVD or only DV camera. Since the claims direct to information on a medium , it would have been obvious to one of ordinary skill

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in the art to motivate using the teaching of logical erasing information of Takahashi with the information of Kikuchi to prevent erroneously erase the content of the recorded information of Kikuchi .

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N


HUY T. NGUYEN
PRIMARY EXAMINER